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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,561	03/11/2004	Chikara Sugai	KIN-15384	7778
40854	7590	03/02/2005		
RANKIN, HILL, PORTER & CLARK LLP 4080 ERIE STREET WILLOUGHBY, OH 44094-7836			EXAMINER GUADALUPE, YARITZA	
			ART UNIT 2859	PAPER NUMBER

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,561

Applicant(s)

SUGAI ET AL.

Examiner

Yaritza Guadalupe McCall

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to Amendment filed February 4, 2005

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1 – 3 are finally rejected under 35 U.S.C. 103 (a) as being unpatentable over Rank (US 5,421,101) in view of Stevenson (US 5,450,909).

With respect to claim 1, Rank discloses a displacement measuring instrument comprising an instrument body (18); a spindle (12) penetrating the instrument body and being slidably supported by the instrument body to be displaced (See Column 2, lines 51 – 54); a lifting lever (15) manipulated from the outside to forcibly shifting the spindle (See Column 4, lines 29 – 31); and an engaging member (bracket receiving connecting screw 300) provided on an outer circumference of the instrument body that detachably engages and supports the lever support, since it could be detached by removing the connecting screws.

With respect to the term “ detachably ” in claim 1 : the term “ detachably ” do not structurally distinguish the claimed invention from Rank. Furthermore, in a broad sense, any structure may be considered to be “ detachably ”, if so desired as long as the structure may be removed by any means, if so desired.

Rank does not disclose a lever support that supports an end of the lifting lever opposite to a drive end of the lifting lever that is in contact with the spindle as stated in claim 1. Rank does not disclose the dovetail arrangement as stated in claim 2. Rank does not disclose the detachment stopper as stated in claim 3.

Regarding to claims 1 - 3 : Stevenson discloses a device having a mounting assembly (16) having a dovetail arrangement including a support (54), a groove (56) formed on said support and a projection (52) formed on the engaging member (32) to be engaged with the groove, in order to removably secure the device in place during use and allow easy removal for safe storage from theft and from contaminants (See Column 4, lines 32 – 34). Stevenson also discloses a detachment stopper (62) which helps in properly placing the apparatus at a desired location and which prevents the lever support from being detached from the engaging member when the lever support is engaged with the engaging member and is slid by a predetermined distance is provided on the engaging member. Therefore, it would have been within the scope of an ordinary skill in the art to modify the instrument disclosed by Rank by replacing the engaging member with a dovetail arrangement including a detachment stopper as taught by Stevenson in order to removably secure the device in place during use and allow easy removal for safe storage from theft (See Column 4, lines 32 – 34).

4. Claim 4 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Rank (US 5,421,101) in view of Stevenson (US 5,450,909), as applied to claims 1 - 3 above, and further in view of Onoda (US 6,187,242).

Rank and Stevenson disclose a device as stated in paragraph 3 above.

Art Unit: 2859

Rank and Stevenson do not disclose the lever support made of a synthetic resin molding as stated in claim 4.

In regards to claim 4 : Rank and Stevenson disclose a device as stated above, having a lever support and an engaging member engaged by a dovetail arrangement, but fail to disclose the particular material used to make the support. Onoda discloses a method for molding connectors by using a primary and secondary synthetic molding process in order to obtain a hard, durable connector with enhanced yielding and high reliability (See Column 2, lines 3 – 5). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a lever support made of a synthetic resin molding in order to obtain a hard, durable support with enhanced yielding and high reliability (See Column 2, lines 3 – 5) and since the courts have held that the particular type of material used to make a support, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

Response to Arguments

5. Applicant's arguments filed February 24, 2005 have been fully considered but they are not persuasive.

6. Applicant argues that there is no reason to combine the prior art of record and questions the motivation statement by reciting that “ the supposition (of removably securing the device in place during use and allow easy removal for safe storage from theft) has no merit and cannot be relied upon as a demonstration of obviousness”. Applicant further questions the desirability of doing so for a lever and argues that there wouldn't be a motivation nor benefits of removing the lever. Applicant also argues that Rank and Stevenson, taken alone or in combination, teach away from the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Rank teaches a displacement measuring instrument having a lever (250) mounted to the instrument body (18) by a support and screws mechanism (300). Stevenson teaches an alternative means for securing a device to a structure, such as the use of a dovetail arrangement.

Art Unit: 2859

Therefore, it is within the skill of an ordinary artisan to replace the means for securing used by Rank with the means for securing disclosed by Stevenson, since the use of the particular type of engaging members by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of engaging members for performing the same function, i.e., fasteners and connectors, and does not involve any inventive step.

It is also pointed out, that the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is whether the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Simon, 174 USPQ 114 (CCPA 1972); In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 196). To emphasize the point further, the Federal Circuit added: "A finding that the prior art as a whole suggests the desirability of a particular combination need not be supported by a finding that the prior art suggests that the combination claimed is the preferred, or most desirable combination. The prior art's mere disclosure of more than one alternative does not constitute the teaching away from the claimed invention because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the patent application" In re Fulton, 391 F. 3d 1195, 73 USPQ2d 1411 (12/2/2004).

In this case, Rank discloses a detachable lever engaged by means of a support and screws mechanism. Stevenson teaches the desirability of providing a removable mounting assembly mainly for “removably secure the device in place during use” and, as an added benefit, to allow easy removal for safe storage from theft and from contaminants (See Column 4, lines 32 – 34), which after all is the main reason of Applicant’s claimed invention. Therefore, replacing one engaging member (i.e., support and screws of Rank) with an alternative, such as the dovetail arrangement taught by Stevenson, is within the skill of an ordinary person in the art of connectors and fasteners, and furthermore, does not involve any inventive steps since the use of alternate engaging members, such as adhesives, dovetail connections, screws, pins, welding, etc, is well known in the art of connectors and fasteners.

Lastly, applicant's argument that the prior art fails to show a lifting lever supported by the lever support to the outer circumference of the instrument body so that no tap or other holes are necessary on the instrument body, thus preventing dust particles from getting into the instrument, are features of the invention which are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

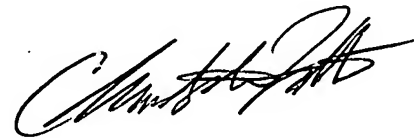
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (571)272 -2244. The examiner can normally be reached on 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2859

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YGM
February 24, 2005



CHRISTOPHER W. FULTON
PRIMARY EXAMINER